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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,889	11/22/1999	MICHAEL G. MIKURAK	AND1P367	9216
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OPPENHEIMER WOLFF & DONNELLY, LLP (ACCENTURE) PLAZA VII, SUITE 3300 45 SOUTH SEVENTH STREET MINNEAPOLIS, MN 55402-1609			EXAMINER VAN DOREN, BETH	
			ART UNIT 3623	PAPER NUMBER

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/444,889	Applicant(s) MIKURAK, MICHAEL G.	
	Examiner Beth Van Doren	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 22, 28, 32-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 22, 28 and 32-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20030301</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/15/2005 has been entered.

2. The following is a non-final office action in response to the request for continued examination received on 12/15/05. Claims 34-38 and 44-55 have been amended. Claims 18, 22, 28, and 32-55 are now pending in this application.

Response to Amendment

3. Applicant's amendments and remarks are sufficient to overcome the 35 USC § 112, first paragraph, rejections of claims 18, 22, 28, and 32-55

4. Applicant's amendments and remarks are sufficient to overcome the 35 USC § 112, second paragraph, rejections of claims 18, 22, 28, and 32-55 with regards to the environment manager and the indexing. However, the amendments to claims 22, 34-35, and 44-49 are not sufficient to overcome the 35 USC § 112, second paragraph, rejections with regards to the system elements. These 35 USC § 112, second paragraph, rejections have been updated to incorporate the current amendments and have been reasserted below.

5. Applicant's amendments and remarks are sufficient to overcome the 35 USC § 101 rejections of claims 18, 32, 33, and 38-43, but are not sufficient to overcome the 35 USC § 101

Art Unit: 3623

rejections of claims 22, 28, 34-37, and 44-55. These rejections have been updated to incorporate the current amendments and have been reasserted below.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22, 34-35, and 44-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 22, 34-35, and 44-49 are computer system claims comprising modules. It is unclear as to how mere module elements (modules are merely being a collection of code) makes up a system as systems must contain at least one hardware element. Clarification is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 22, 28, 34-37, and 44-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 22, 34-35, 44-49 recite a system claims comprising modules. A module, in its broadest reasonable interpretation, is merely a collection of code (or software per se). Therefore, claim 44 recites a collection of modules (or software). Therefore, claim 44 does not meet one of the four statutory classes, as a collection of code is not a system (as explained in the 35 USC § 112, second paragraph, rejections above) and a collection of code is not a product, unless a unless accompanied by a computer readable medium and recited as executable in that medium.

Art Unit: 3623

Dependent claims 22, 34-35, 45-49 do not confer statutory subject matter on claim 44 and therefore contain the same deficiencies. Therefore, it is respectfully submitted that claims 22, 34-35, and 44-49 are directed towards non-statutory subject matter.

Claims 28, 36-37, and 50-55 recite “a computer program embodied on a computer readable medium” comprising code segments. A collection of code segments embodied on a computer readable medium is not considered statutory subject matter unless it is also recited as executable in that medium. Therefore, since the computer program embodied on a computer readable medium of claim 50 is not also recited as executable, and since claims 28, 36-37, and 51-55 do not cure this deficiency, it is respectfully submitted that claims 28, 36-37, and 50-55 are directed towards non-statutory subject matter.

Response to Arguments

10. Applicant’s arguments with regards to Sekizawa (U.S. 6,430,711) have been fully considered, but they are not persuasive. In the remarks, Applicant argues that Sekizawa does not teach or suggest (1) an e-commerce environment manager managing the e-commerce environment that is independent and unassociated with the provider and consumers and performs maintenance activities on the e-commerce supply chain environment, (2) receiving both recommendations for maintenance and service as well as requests for maintenance and service, (3) scheduling service and transmitting the schedule for the service, (4) the supply chain environment manager performing the scheduled maintenance and service.

In response to argument (1), Examiner points out that the term “manager” is recited in the preamble of claims 38, 44, and 50. However, these claims contain no clear recitation that links the manager of the preamble to any specific elements found in the body of the claims. Applicant

Art Unit: 3623

has argued that the manager of the claimed invention performs maintenance activities on the e-commerce supply chain environment. Contrary to this statement, claims 38, 44, and 50 all recite that scheduled maintenance and service of the e-commerce supply chain environment is performed without stating who specifically performs the maintenance and service. None of these claims expressly state that the maintenance and service is performed by the supply chain environment. In fact, claim 38, for example, states that notices are received from a plurality of providers users and requests service are received from a plurality of consumer users, and maintenance and service is scheduled using the plurality of notices and the plurality of requests. Therefore, in the broadest reasonable interpretation, it appears that the providers (i.e. service providers) are performing the maintenance and service for the consumers.

Sekizawa discloses a computer-implemented system with the capability of monitoring and servicing a plurality of machines with a computer-implemented manager unit. Providers dispatch technicians to consumer users when fault needing maintenance occur. Therefore, Sekizawa teaches the invention, as claimed.

In response to argument (2), Examiner respectfully disagrees. Faults and errors are made known through both the requests of the consumers (i.e. the consumer notifies the provider when a problem occurs with his/her equipment) and the recommendations of the providers (i.e. the providers contact the consumers when a problem continues to occur with his/her equipment. See column 2, line 50-column 3, line 25, column 4, lines 50-65, column 5, lines 40-50, and column 6, lines 55-65, column 8, lines 1-17.

In response to argument (3), Examiner respectfully disagrees. Examiner first points out the alternative language used in element (d) in each of claims 38, 44, and 50. For example, claim

Art Unit: 3623

38, states that maintenance and service is scheduled using the plurality of notices and the plurality of request and that this schedule is transmitted to the plurality of users who requested or recommended maintenance (i.e. only one of the providers or consumers must be transmitted the schedule to meet this limitation). Sekizawa discloses that maintenance and service is scheduled based on the plurality of notices and the plurality of requests (i.e. the monitoring user (provider) notifies the consumer of problems associated with his/her machines or the consumer notifies the provider of problems with his/her machines). Once a plan for dispatching a maintenance person to the consumer is arranged, it is transmitted amongst the provider users who recommended the maintenance and service. Thus the maintenance personnel of the provider users are informed of the schedule to fix the machines of the consumers. See figure 28 and column 4, lines 50-65, column 5, lines 40-60, and column 6, lines 55-65, column 8, lines 1-36, wherein the scheduling is made known to the users who recommended the maintenance via a phone call

In response to argument (4) that the references fail to show certain features of applicant's invention, it is noted that the feature upon which applicant relies (i.e., the supply chain environment manager performing the scheduled maintenance and service) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claims 38, 44, and 50 all recite that scheduled maintenance and service of the e-commerce supply chain environment is performed. However, none of these claims expressly state that the maintenance and service is performed by the supply chain environment manager. Therefore, Sekizawa teaches that maintenance is performed in at least

Art Unit: 3623

column 4, lines 5-25 and 40-62, column 5, lines 40-50, column 6, lines 55-65, column 7, lines 35-50, and column 8, lines 1-7.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 18, 22, 28, 32-38, 40-44, 46-50, and 52-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Sekizawa (U.S. 6,430,711)

12. As per claim 38, Sekizawa discloses a method for an e-commerce supply chain environment manager to provide maintenance and service for a network-based e-commerce supply-chain environment between a first environment user and a second environment user, comprising:

(a) receiving from a plurality of provider environment users a plurality of notices for recommended maintenance and service (See column 2, line 50-column 3, line 25, column 4, lines

Art Unit: 3623

50-65, column 5, lines 40-50, and column 6, lines 55-65, wherein users recommend maintenance and service using the network);

(b) receiving from a plurality of consumer environment users a plurality of requests for maintenance and service (See figure 28 and column 2, line 50-column 3, line 28, column 4, line 50-column 5, line 10 and 40-50, and column 6, lines 1-6 and 55-65, column 7, lines 25-50, and column 8, lines 1-17, wherein the second framework user requests maintenance and service);

(c) scheduling maintenance and service using the plurality of notices and the plurality of requests (See column 2, line 50-column 3, line 25, column 4, lines 50-65, column 5, lines 40-50, column 6, lines 55-65, column 7, line 59-column 8, line 36, wherein maintenance and service is scheduled using the requests and notices);

(d) transmitting a schedule to the plurality of users who requested or recommended maintenance (See figure 28 and column 4, lines 50-65, column 5, lines 40-60, and column 6, lines 55-65, column 8, lines 1-36, wherein the scheduling is made known to the users who recommended the maintenance via a phone call);

(e) performing scheduled maintenance and service of the e-commerce supply chain environment (See column 4, lines 5-25 and 40-62, column 7, lines 35-50, and column 8, lines 1-7, wherein maintenance is performed. See also figure 20 and column 2, line 50-column 3, line 25 and 45-55, column 5, lines 40-50, and column 6, lines 55-65, wherein other maintenance is performed).

13. As per claim 18, Sekizawa teaches performing load-balancing services that initiate and stop processes as utilization levels vary in the e-commerce supply chain (See column 6, lines 10-35, which discloses load balancing).

Art Unit: 3623

14. As per claim 32, Sekizawa teaches wherein the step of performing scheduled maintenance and service includes indexing received feedback from environment users (See figures 4, 9-12, and 30, column 7, lines 59-67, column 19, lines 35-45, column 20, line 40-column 21, line 10, wherein the user is given a change request, the system has a mail box for receiving change requests, and the system saves this data. See also column 22, lines 25-55, column 23, lines 1-30, column 33, lines 35-65, column 34, line 55-column 35, line 25).

15. As per claim 40, Sekizawa teaches wherein the step of performing scheduled maintenance and service of the e-commerce supply chain environment comprises synchronizing data stored separately from the e-commerce supply chain environment with data stored in the e-commerce supply chain environment (See column 4, lines 5-25 and 40-62, column 7, lines 35-50, and column 8, lines 1-7, wherein the external, global, data and the local data is synchronized).

16. As per claim 41, Sekizawa teaches wherein the step of performing scheduled maintenance and service of the e-commerce supply chain environment comprises optimizing at least one operation of the environment from the group consisting of server processes, disk space, memory availability, CPU utilization access time to a server, and a number of connections in a network-based supply chain for efficient system-operation and problem prevention (See figure 20 and column 2, lines 50-67, column 3, lines 1-25 and 45-55, column 5, lines 40-50, and column 6, lines 55-65, wherein at least one operation of the environment is monitored for optimization, including memory availability).

17. As per claim 42, Sekizawa teaches wherein the step of performing scheduled maintenance and service of the e-commerce supply chain environment comprises sending

Art Unit: 3623

feedback response requests to the plurality of environment users of the e-commerce supply-chain environment (See figures 4, 9-12, and 30, column 7, lines 59-67, column 19, lines 35-45, column 20, line 40-column 21, line 10, column 22, lines 25-55, column 23, lines 1-30, column 33, lines 35-65, column 34, line 55-column 35, line 25, wherein the user is given a change request and there is a mail box for receiving change requests. Also, the user can input information requested by the system, such as error information, status information, customer information, etc.).

18. As per claim 43, Sekizawa teaches searching the data stored in the e-commerce supply chain environment prior to synchronization (See column 4, lines 5-25 and 40-62, column 7, lines 35-50, and column 8, lines 1-7, wherein the status data of the local machines are searched prior to the synchronization).

19. As per claim 33, Sekizawa teaches wherein the data stored in the e-commerce supply-chain environment is indexed according to a profile for each environment user's profile (See figures 4, 9-12, and 30, column 7, lines 59-67, column 19, lines 35-45, column 20, line 40-column 21, line 10, wherein information is entered in the system and saved based on the user profile. For example, the user is given a change request, the system receives change requests, and the system saves this data with the profile of the user. See also column 22, lines 25-55, column 23, lines 1-30, column 33, lines 35-65, column 34, line 55- column 35, line 25).

20. Claims 44, 22, 34, 46-49, and 35 recite equivalent limitations to claims 38, 18, 32, 40-43, and 33, respectively, and are therefore rejected using the same art and rationale as applied above.

21. Claims 50, 28, 36, 52-55, and 37 recite equivalent limitations to claims 38, 18, 32, 40-43, and 33, respectively, and are therefore rejected using the same art and rationale as applied above.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 39, 45, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekizawa (U.S. 6,430,711) and Haluska (U.S. 5,638,519).

23. As per claim 39, Sekizawa teaches wherein the step of performing scheduled maintenance and service of the e-commerce supply chain environment comprises updating internal data items stored in the environment (See column 4, lines 5-25 and 40-62, column 7, lines 35-50, and column 8, lines 1-7, wherein the internal data items of the local framework are updated). However, Sekizawa does not expressly disclose and Haluska discloses updating internal data items selected from the group consisting of merchandising content, currency exchange rates, tax rates, and pricing information (See figures 4-6, column 3, lines 25-40 and 45-65, column 5, lines 1-25, column 7, lines 35-60, and column 11, lines 35-65, wherein pricing information is updated);

Both Haluska and Sekizawa disclose manufacturers providing services and supplies to users of the network. Sekizawa further discloses the ability to update internal information such as the customer information. It is well known in marketing and sales to customize merchandising content and/or pricing information to the customer and the customer's information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to update at least the merchandising content and/or the pricing information based

Art Unit: 3623

on this change in customer information in order to more efficiently meet the needs of the customers of the system by maintaining universal and updated information accessible by all users of the network that correctly matches the needs/information about the customers. See column 2, lines 50-67, of Haluska and column 2, lines 45-67, of Sekizawa.

24. Claim 45 recites equivalent limitations to claim 39 and is therefore rejected using the same art and rationale as applied above.

25. Claim 51 recites equivalent limitations to claim 39 and is therefore rejected using the same art and rationale as applied above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (571) 272-6737. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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March 02, 2006

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